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In re Application of :
Saito et al. :
Application No.: 10/577,876 : DECISION
PCT No.: PCT/JP04/15529 :
Int. Filing Date: 20 October 2004 :
Priority Date: 11 November 2003 :
Attorney Docket No.: 403696SOEI :
For: Method For Glossing Solid Surface :
And Film-Forming Coating Liquid :
PETITION

This is in response to the petition under 37 CFR 1.47(a) filed on 06 November 2006.

BACKGROUND

This international application was filed on 20 October 2004, claimed an earlier priority date of 11 November 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 19 May 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 11 May 2006. Applicants filed *inter alia* the basic national fee on 28 April 2006.

On 01 November 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration compliant with 37 CFR 1.497(a) and (b), a surcharge under 37 CFR 1.492(h), the \$400.00 search fee, and the \$200.00 examination fee.

DISCUSSION

The submission filed on 06 November 2006 included the surcharge under 37 CFR 1.492(h), the \$400.00 search fee, and the \$200.00 examination fee, as well as the instant petition and fee under 37 CFR 1.47(a). A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee was paid on 06 November 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Masahiro Makino be excused because he allegedly refused to sign the declaration. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition

In support of the proposition that Mr. Makino has refused to execute the declaration, counsel has provided evidence including a copy and translation of e-mail correspondence from Mr. Makino to Naoki Ogura, dated 25 May 2006. In this e-mail, Mr. Makino states that

It's been a long time. My answer to the patent issue is the same as before. I cannot change my mind once I make a resolution. Last time I refused. So, if this time I agree, it is a contradiction.

However, this e-mail evidence does not clearly establish that Mr. Makino is refusing to sign the declaration document for the instant application under 35 U.S.C. 371. Rather, Mr. Ogura's e-mail to Mr. Makino refers to not only the declaration, but also to an assignment pertinent to the U.S., an assignment pertinent to Canada, and a preliminary amendment. The evidence of record does not clearly establish that Mr. Makino is specifically refusing to sign the declaration, as opposed to one or more of the other documents. Moreover, petitioner has not established that the refusal occurred after Mr. Makino was presented with a complete copy of the application papers for the instant application; neither the Declaration of Mr. Ogura nor the e-mail

evidence of record refers to a copy of the application as having been presented to him. For these reasons, it would not be appropriate to conclude on the basis of the present record that requirement (2) has been satisfied.

Regarding requirement (3), the petition includes a statement of the last known address of Masahiro Makino. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), the declaration filed on 06 November 2006 has been signed by joint inventors Toru Saito, Hirofumi Tochikawa and Hideaki Tojo on behalf of themselves and non-signing joint inventor Masahiro Makino. This declaration is acceptable for purposes of compliance with 37 CFR 1.497(a) and (b) and 1.47(a). As such, requirement (4) has been satisfied.

DECISION

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



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